

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed February 8, 2002. At the time of the Office Action, Claims 19, 22, 25, and 26 were pending in this patent application. Applicant has amended Claim 19 to more clearly claim what Applicant believes to be the invention. Applicant respectfully submits that this amendment will not require a new search to be conducted and will not necessitate new or different grounds of rejection. Accordingly, Applicant respectfully requests entry of this amendment and reconsideration of and favorable action in this case.

Claims 19, 22, 25 and 26 are Allowable

The Examiner rejects Claims 19, 22, 25 and 26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 4,623,965 to Wing ("*Wing*") in view of U.S. Patent Number 5,542,487 to Schultz, et al. ("*Schultz*") and U.S. Patent Number 5,050,207 to Hitchcock ("*Hitchcock*").

Independent Claim 19, as amended, recites the following limitations:

A portable check encoding device, comprising:
an input device operable to receive a check amount from a user and further operable to receive a selection of a payee name from a list of payee names by the user;
a memory operable to store and recall the list of payee names;
a display operable to display the check amount entered by the user and the list of payee names; and
a portable check printer operable to:
receive the check amount from the input device and encode the check amount in magnetic ink at a predetermined location on a check; and
receive the selected payee name and print the selected payee name in a payee field on the check.

As admitted by the Examiner, *Wing* and *Schultz* lack a teaching of an input receiving a payee name selected from a list of payee names by the user, a memory operable to store and recall payee names, and a display to display the list of payee names memory to recall a list of payee names. However, the Examiner asserts that the *Hitchcock* teaches these features and that the combination of *Wing*, *Schultz*, and *Hitchcock* discloses each and every limitation of Claim 19.

Assuming for purposes of argument that the proposed combination discloses the limitations of Claim 19, the Examiner has not cited language in any of the references or within information commonly known to those skilled in the art that provides the necessary motivation or suggestion to combine these three references. Further, it would not be obvious to one skilled in the art to make the combination.

It is a primary purpose of the device of *Wing* to provide a portable, handheld electronic checkbook. Similarly, it is a primary purpose of *Schultz* to provide a check printer to be linked to a portable data collection terminal. The device disclosed in *Hitchcock* is portable automated teller machine that has no capability of producing a check. Instead, it describes a system for electronically debiting an account, and thus teaches away from having to produce a check to debit an account. Therefore, there is no suggestion to combine features of the electronic checkbook of *Wing* and the check encoding printer of *Schultz* with the automated teller machine of *Hitchcock* to yield the portable check encoding device recited in the present claims.

As required by the Patent Office, the Examiner has not shown a suggestion or motivation in the references or in the knowledge generally available to one of ordinary skill in the art to combine the cited references. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination." M.P.E.P. § 2143.01. Thus, the mere fact that the teachings of one reference would improve the teachings of another reference as asserted by the Examiner, does not provide the required suggestion to combine. Nothing in *Wing*, *Schultz* or *Hitchcock*, or any other cited reference, suggests or motivates the proposed combination, nor has the Examiner provided any evidence that suggests the proposed modification.¹ The Examiner speculates "it would have been obvious" to make the proposed combination since "one of ordinary skill in the art would have readily recognized that storing the list of payees in a memory provides the user with a short-cut and time-saving method to print the payees name

¹ If the Examiner is relying on "common knowledge" or "well known" art in support of his rationale for combining the references, the Examiner is requested to produce a reference in support of his position pursuant to M.P.E.P. § 2144.03. If the Examiner is relying on personal knowledge to supply the required motivation or suggestion to combine, Applicants respectfully request that the Examiner produce an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

in the payee field of the check." The Examiner, however, presents no evidence that suggests or motivates the combination as is required by Federal Circuit case law.² The M.P.E.P. also confirms that this approach is improper and should not be used here.³

For at least the reasons given above, Applicant respectfully requests reconsideration and allowance of Claim 19 together with Claims 22, 25 and 26, which depend from Claim 19.

² In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Conclusory statements by the Examiner regarding the teaching of multiple references, standing alone, are not "evidence." *Id.*

³ See M.P.E.P. § 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to lack of suggestion in the prior art of the desirability of combining references."), *See also In re Jones*, 958 F.2d 347 ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].")

CONCLUSION

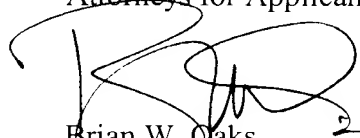
Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicant, at the Examiner's convenience at (214) 953-6986.

Applicant does not believe that any additional fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,

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Date: April 8, 2002

MARKED UP VERSION OF CLAIM AMENDMENTS

IN THE CLAIMS

For the convenience of the Examiner, all claims have been presented whether or not an amendment has been made. The claims have been amended as follows:

19. **(Amended)** A portable check encoding device, comprising:
an input device operable to receive a check amount from a user and further operable to receive a **selection of a** payee name **[selected]** from a list of payee names by the user;
a memory operable to store and recall the list of payee names;
a display operable to display the check amount entered by the user and the list of payee names; and
a portable check printer operable to:
receive the check amount from the input device and encode the check amount in magnetic ink at a predetermined location on a check; and
receive the selected payee name and print the selected payee name in a payee field on the check.
22. The portable check encoding device, as set forth in claim 19, wherein the check printer is operable to encode the check amount on a MICR line of the check.
25. The portable check encoding device, as set forth in claim 19, wherein the check printer is further operable to print the check amount alphabetically in an alphabetical amount field and numerically in a numerical amount field on the check.
26. The portable check encoding device, as set forth in claim 19, wherein the check received by the check printer is a blank check, the blank check including an account number but not a payee name or check amount.